

REMARKS

Applicants note with appreciation that, in the Office Action of September 27, 2007, claims 3, 12 and 22 were allowed. However, claims 1, 2, 5-8, 11 and 13-16 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over European Patent Application No. EP 0 957 448 A2 (“McCallister et al.”) in view of PCT Application No. WO 01/61451 A2 (“Hollstrom”). In addition, claim 20 was rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent No. 6,433,780 (“Gordon et al.”) in view of McCallister et al. Furthermore, claims 4, 9, 10, 17, 18 and 21 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable in view of McCallister et al., Hollstrom, Gordon et al., U.S. Patent No. 6,963,059 (Lauffenburger et al.) and/or U.S. Patent No. 5,442,147 (“Burns et al.”).

In response, Applicants have amended the independent claims 1 and 11 to recite the same limitations as the allowed claims 3 and 12, respectively, with minor corrections. Thus, the allowed claims 3 and 12 have been canceled. As such, Applicants respectfully request that the amended independent claims 1 and 11 be allowed. Applicants have also amended the independent claim 20 to more clearly distinguish the claimed invention from the cited references of Gordon et al. and McCallister et al. New independent claim 23 has also been added. As explained below, the independent claims 20 and 23 are allowable in view of the cited references. Applicants have also added a new dependent claim 24 and have amended claims 21 and 22. In view of the claim amendments and the following remarks, Applicants respectfully request that claims 1, 2, 4-11, 13-18 and 20-24 be allowed.

I. Patentability of Amended Independent Claim 20

As amended, the independent claim 20 recites in part “*acquiring a first frame from said self-illuminated surface at a single detector of said electronic device*” and “*acquiring a second frame at said single detector from said self-illuminated surface,*” which are not disclosed in the cited references of Gordon et al. and McCallister et al. Thus, Applicants respectfully assert that the independent claim 20 is not obvious in view of the cited references of Gordon et al. and McCallister et al., and request that the amended independent claim 20 be allowed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Office Action on page 8 asserts that the cited reference of Gordon et al. discloses “acquiring a first frame from said illuminated surface (Figure 5, step 31) at a single detector (Column 10, lines 39-43 explain that the images are taken using a photo detector) of said electronic device” and “acquiring a second frame at said single detector from said illuminated surface (Figure 5, step 33).” Although the cited reference of Gordon et al. does disclose acquiring frames, the acquired frames are frames from a work surface, not frames from a self-illuminated surface, as recited in the amended independent claim 20. Thus, the cited reference of Gordon et al. does not disclose acquiring frames from a self-illuminated surface. The cited reference of McCallister et al. also does not disclose acquiring frames from a self-illuminated surface. Thus, the cited references of Gordon et al. and McCallister et al. even when combined do not teach or suggest all the limitations of the amended independent claim 20. Consequently, the amended independent claim 20 is not obvious in view of the cited references of Gordon et al. and McCallister et al. As such, Applicants respectfully request that the amended independent claim 20 be allowed.

Applicants note herein that although the cited reference of McCallister et al. does state in paragraph [0061] that any surface may be used, the surfaces that can be used with respect to the mouse of McCallister et al. are not self-illuminated surfaces. This is supported by the fact that some sort of external illumination is used to illuminate the surface on which the mouse of McCallister et al. is used. As described in paragraph [0048] of McCallister et al., the external illumination may be ambient light. Alternatively, as described in paragraph [0049], the external illumination may

be LED illumination 172. Thus, the surface on which the mouse of McCallister et al. is used is not a self-illuminated surface.

Since the cited references of Gordon et al. and McCallister et al. do not disclose the limitations of “*acquiring a first frame from said self-illuminated surface at a single detector of said electronic device*” and “*acquiring a second frame at said single detector from said self-illuminated surface,*” the amended independent claim 20 is not obvious in view of these references. As such, Applicants respectfully request that the amended independent claim 20 be allowed.

II. Patentability of New Independent Claim 23

The new independent claim 23 recites in part “*a display screen including a self-illuminated surface having a detectable texture*” and “*an optical screen navigation device*” that includes “*an optical motion detection circuit configured to produce motion signals indicative of motion of said surface relative to said detectable texture of said self-illuminated surface,*” which are not disclosed in the cited reference of McCallister et al. Thus, Applicants respectfully assert that the new independent claim 23 is not obvious in view of the cited references, and request that the new independent claim 23 be allowed.

As explained above in Section I, the cited reference of McCallister et al. does not disclose using a self-illuminated surface. Thus, the cited reference of McCallister et al. and any other cited references even when combined do not disclose all the limitations of the new independent claim 23. As such, Applicants respectfully assert that the new independent claim 23 is not obvious in view of the cited references, and request that the new independent claim 23 be allowed.

III. Patentability of Dependent Claims 2, 4-10, 13-18 and 21 and 24

Each of the dependent claims 2, 4-10, 13-18 and 21 and 24 depends on one of the independent claims 1, 11, 20 and 23. As such, these dependent claims include all the limitations of their respective base claims. Therefore, Applicants submit that

these dependent claims are allowable for at least the same reasons as their respective base claims.

Applicants respectfully request reconsideration of the claims in view of the remarks made herein. A notice of allowance is earnestly solicited.

Respectfully submitted,
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